

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT S. MUELLER and DAVID P. GODLEW

Appeal No. 97-2610
Application 08/236,809¹

ON BRIEF

Before STAAB, McQUADE and NASE, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Robert S. Mueller et al. appeal from the final rejection of claims 1 through 10, all of the claims pending in the

¹ Application for patent filed May 2, 1994.

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application.²

The invention relates to an isolator for attenuating and dampening vehicle driveline torsionals (i.e., pulses) generated by accelerations/decelerations of the vehicle's engine. A copy of the appealed claims (with reference numerals added) appears in the appendix to the appellants' brief (Paper No. 17).

The instant application is one of four related applications filed concurrently on May 2, 1994 by Eaton Corporation, the assignee of entire interest in each of the applications. Three of the applications, Applications 08/236,809, 08/236,835 and 08/236,838, are currently on appeal to this Board from a final rejection,³ and the fourth, Application 08/236,069, has matured into U.S. Patent No. 5,577,963, issued on November 26, 1996.

² Claims 1, 3, 6 and 8 have been amended subsequent to final rejection.

³ Application 08/236,809 is the instant application, Application 08/236,835 is the subject of Appeal No. 97-3085 and Application 08/236,838 is the subject of Appeal No. 97-2221.

The disclosures in the four applications are essentially identical and pertain to a torsion isolator having, among other features, (1) a spring disposed in a liquid pressure dampener and functioning as a piston, (2) a pivot stop associated with the spring, (3) a counterbalance associated with the spring, and (4) a control means associated with the spring for momentarily providing hydraulic slack or delay in the dampening operation.

The claims in the four applications are directed to an isolator having one or more of these features. As described by the appellants, "[i]n brief, the gist[s] of the four inventions in the '069, '809, '835 and '838 applications are respectively the pivot stop D, the counterbalance C, the momentary delay of dampening or hydraulic [slack] provided by the control means E, and the spring A₂ or A₃ disposed in the liquid pressure dampener B₂ and functioning as a piston" (brief, page 20⁴).

⁴ The appellants have used the letters A, B, C, D and E in the brief to simplify reference to the various features of the isolator.

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The claims in each of the applications on appeal stand finally rejected under the judicially created doctrine of double patenting in view of the claims in each of the other three related applications. With specific regard to the instant appeal, the examiner states the rejection as follows:

Claims 1-10 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-8 of copending Application No. 08/236,069, over claims 1-15 [sic, claims 1, 2, 4-7, 9-13 and 15-21] of copending Application No. 08/236,835, and over claims 1-34 [sic, claims 1-6, 8-12, 14-20, 22-27 and 29-34] of copending Application No. 08/236,838. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.^[5]

The subject matter claimed in the instant application is fully disclosed in the referenced copending application[s] and would be covered by any patent[s] granted on that copending application [sic, those copending applications] since the referenced copending application[s] and the instant application are claiming common subject matter, as follows: generic torque transmitting resilient means, torque transmitting c-shaped spring, torque transmitting c-shaped spring functioning as a

⁵ "Provisional" rejections of the sort here involved are authorized by MPEP § 804 and have been sanctioned by this Board (see Ex parte Karol, 8 USPQ2d 1771 (Bd. Pat. App. & Int. 1988)) and by the predecessor of our reviewing court (see In re Wetterau, 356 F.2d 556, 148 USPQ 499 (CCPA 1966)). As indicated above, Application 08/236,069 has matured into U.S. Patent No. 5,577,963. Thus, to the extent that the appealed rejection is based on the claims in Application 08/236,069, the "provisional" designation no longer applies.

piston.

Furthermore, there is no apparent reason why applicant[s] would be prevented from presenting claims corresponding to those of the instant application in the other copending application[s]. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804 [answer, Paper No. 18, page 3].

Reference is made to the appellants' brief and to the examiner's answer for the respective positions of the appellants and the examiner with regard to the merits of this rejection.⁶

In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968), cited by the examiner in support of the appealed rejection, stands for the principle that under certain circumstances a double patenting rejection other than one of the statutory same-invention-type or judicially created obviousness-type may be employed to prevent an unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about (397 F.2d at 354, 158 USPQ at 214).

⁶ The final rejection also included 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103 rejections which have since been withdrawn by the examiner (see the advisory actions dated March 8, 1996 and May 31, 1996, Paper Nos. 9 and 12).

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Accord In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982). The offending situation in Schneller involved a patent and a subsequent continuing application filed voluntarily instead of in response to a restriction requirement. The patent and the application contained common disclosures and claims which all could have been included in the patent. The claims in the application, if allowed, would afford patent protection on an invention fully disclosed in and covered by the claims in the patent. Under these circumstances, the court found that the application claims, if allowed without the filing of a terminal disclaimer, would provide an unjustified timewise extension of the right to exclude granted by the patent. Given the absence of a terminal disclaimer, the court affirmed the double patenting rejection entered against the application claims.

As indicated above, Applications 08/236,809, 08/236,835, 08/236,838 and 08/236,069 contain essentially identical disclosures. These applications are commonly assigned and were voluntarily filed as separate applications even though there is no apparent reason why the claims contained in each could not have been included in a single application. Also,

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none of the applications includes a terminal disclaimer. Thus, depending on the scope of the claims, the potential certainly exists for one or more of the applications on appeal, if allowed, to provide an unjustified timewise extension of the right to exclude granted by a patent maturing from any of the other applications.

The appellants' brief (see pages 18 through 20) contains a tabular summary of the scope of the respective sets of claims involved in the double patenting issue presented in this appeal. This summary, and our own review, indicate that the claims in the instant application, if allowed, would not result in any timewise extension of the right to exclude afforded by the claims in Applications 08/236,838, 08/236,835 and 08/236,069 (Patent No. 5,577,963). The examiner's determination to the contrary as set forth in the answer is fundamentally flawed in that it fails to take into account the subject matter as a whole recited in these claims.

Accordingly, we shall not sustain the examiner's double patenting rejection of claims 1 through 10.

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The decision of the examiner is reversed.

REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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JOHN P. McQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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